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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,553	06/19/2006	Eckhard Just	284353US0PCT	9842
22850	7590	11/13/2007	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NWAONICHA, CHUKWUMA O	
			ART UNIT	PAPER NUMBER
			1621	
			NOTIFICATION DATE	DELIVERY MODE
			11/13/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/583,553		JUST ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Chukwuma O. Nwaonicha		1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Current Status***

1. Claims 1-18 are pending in the application.

### ***Priority***

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

### ***Claim Objection***

Claim 8 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 12, 14 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6, 12, 14 15 and 16 are indefinite because the words or substituents; -o-, -o-CH<sub>2</sub>-, abs, and 1 t. It is not clear what Applicants intend to be claiming. Correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim** 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Jenke et al., {US 5,869,728}.

Jenker et al. disclosed a process for preparing fluoroalkyl organosilicon compounds by reacting fluoroolefins with organosilicon compounds that contain at least one H--Si group, in the presence of a Pt(0) complex catalyst. Further, fluoroalkylalkoxy organosilicon compounds are prepared by esterifying fluoroalkyl organosilicon compounds. The process proceeds uniformly under mild conditions with high yields and selectivities. See columns 2-6.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jenker et al., {US 5,869,728}.

Applicants claim a process for preparing a silicon compound bearing at least one fluoroalkyl group by hydrosilylation of a fluoroolefin in the presence of a Pt-containing hydrosilylation catalyst; wherein all the other variables are as defined in the claims.

**Determination of the scope and content of the prior art (M.P.E.P. §2141.01)**

Jenker et al. teach a process for preparing fluoroalkyl organosilicon compounds by reacting fluoroolefins with organosilicon compounds that contain at least one H--Si group, in the presence of a Pt(0) complex catalyst. The weight ratio of the total amount of platinum to the total amount of the fluoroolefin is 1:100 to 1:100,00. Further, fluoroalkylalkoxy organosilicon compounds are prepared by esterifying fluoroalkyl organosilicon compounds. The process proceeds uniformly under mild conditions with high yields (99%) and selectivities. The reaction is conducted in an inert solvent, N<sub>2</sub> atmosphere, at a temperature between 10°C to 200°C, pressure of about 1 to 50 bar and reaction time of about 7 hours. See columns 2-6.

**Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)**

Jenker et al. process for preparing silicon compound differs from the instantly claimed process in that applicants' claimed process employs denatured alcohol while Jenker et al. teach a process that employed alcohol in general including denatured alcohol. Applicants recite the properties of fluoroolefin as having iodine content of less than 150 ppm by weight, diene content of less than 100 ppm by weight and a water content of less than 100 ppm by weight while Jenker et al. is silent about these properties. Additionally, applicants claim a process wherein the fluoroolefin is metered in at a rate of from 50 to 300 l/h while Jenker et al. is silent about it.

**Finding of prima facie obviousness--rational and motivation (M.P.E.P. §2142-2143)**

The instantly claimed process for preparing silicon compound would have been suggested to one of ordinary skill because one of ordinary skill wishing to obtain silicon compound is taught to employ the process of Jenker et al.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by varying the process conditions from the teaching of Jenker et al. to arrive at the instantly claimed process for preparing silicon compound. Said person would have been motivated to practice the teaching of the reference cited because it demonstrates that silicon compounds are useful in industrial applications.

The Examiner notes that varying the order of addition of the reactants, temperature, catalyst or reactants in a chemical reaction is a well-known chemical

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practice to optimize the process efficiency of the system and does not constitute a patentable distinction. Simply reversing the order of steps in a multi-step process is not a patentable modification absent unexpected or unobvious results. Ex parte Rubin, 128 U.S.P.Q. 440 (P.O.B.A 1959). It should be noted that the iodine content of less than 150 ppm by weight, diene content of less than 100 ppm by weight and a water content of less than 100 ppm by weight as recited by the applicants are inherent properties of fluoroolefin compounds and do not constitute a patentable distinction.

Moreover, all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Additionally, merely modifying the process conditions such as temperature and concentration is not a patentable modification absent a showing of criticality. In re Aller, 220 F.2d 454, 105 U. S. P. Q. 233 (C. C. P. A. 1955). Therefore, the instantly claimed invention would therefore have been obvious to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached on 571-272-0871. The fax phone


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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chukwuma O. Nwaonicha, Ph.D.  
Patent Examiner  
Art Unit: 1621

**J. PARSA  
PRIMARY EXAMINER**

*for* 

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Yvonne (Bonnie) Eyler  
Supervisory Patent Examiner,  
Technology Center 1600